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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,814	05/30/2001	Steffanie G. Waddington	11867.0003.NPUS00 (MKSS:0)	6624

7590

03/14/2006

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EXAMINER
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CUFF, MICHAEL A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/867,814

Applicant(s)

WADDINGTON ET AL.

Examiner

Michael Cuff

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Appeal Brief***

1. Applicant has submitted a second appeal brief, 11/15/05, to overcome formality issues. Unfortunately, there are still formality issues and a major content issue that cannot be resolved with just another appeal brief. A new final rejection office action, necessitated by applicant's amendment, dated 8/17/04, is contained in this action. Note that a new primary reference, Radican, is being applied. Radican was found while searching the content of claim 63.

The major content issue is that there are three claims, 61-63, in the application, which have not been finally rejected. Page 1, line 1, of applicant's 8/17/04 response states, "Claims 17-60 are pending." The examiner apologizes for not seeing the 3 additional claims. In the future, the examiner recommends that applicant should just call the office to report a few claims missing from the rejection. Another action can easily be generated to address the miscommunication.

2. Other problems with the appeal brief for future use:

Currently section III, "Status of the claims" from the 11/15/05 appeal brief discusses only claims 61 and 62, but does not refer to claim 63.

Applicant is not using the most recent 37 CFR 41.37(c) rules. If applicant is unaware of the current rules, the examiner recommends looking them up on the USPTO public website [www.uspto.gov](http://www.uspto.gov). From the welcome page, select "Guides" on the top menu. The next page will have a box in the top center, labeled "patent", select the 5<sup>th</sup>

item, "Manual of Patent Examining Procedure". Scroll down to "Appendix R – Patent Rules", you will have a choice of PDF or HTML formats. Scroll down to section 41.37.

Currently section V, "Summary of claimed subject matter" is inadequate for two reasons. First, the cited pages of 5-6 in the specification do not show the claim subject matter of "independently identifying". Second, appellant must refer to the specification by page and line number, and to the drawing, if any, by reference characters. Please note that this does not say specification or drawing. For claim 17, appellant should incorporate items from figure 3 at a minimum.

Currently section VI, "Issues on Appeal", and section VII, "Grouping of the Claims", are improper. See 37 CFR 41.37(c) for the proper headings.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 62 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's specification does not disclose acknowledging the receipt of a plurality of items. The examiner believes that applicant is confusing the acknowledging a receiving an order with acknowledging receiving items.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claim 61 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 61 recites using the electronic shipment record received prior to delivering the shipping unit to the customer. It is not clear what step is being done when "using the electronic shipment record received". From the specification, the electronic shipment records received are used to coordinate receiving of the plurality of items. The examiner suggests that applicant might try this claim language: --

The method of claim 17 in which the step of identifying the shipping unit further comprises coordinating receipt of the plurality of items based on the electronic shipment record received prior to delivering the shipping unit to the customer. --

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Radican in view of Reber et al.

Radican shows all of the limitations of the claims except for placing an identification label on the shipping unit, and the customer's ability to electronically read the identifier on the label upon receiving the shipping unit.

Radican shows a container and inventory monitoring methods and systems provide detailed logistical control of containers, shipping racks and resident and in-transit inventory. From columns 14 and 15, at step 1308 on FIG. 13B, the supplier generates an advanced shipping notice (ASN) (electronic shipment record) for transmission to the customer. The ASN includes the part number, supplier code, release order, purchase order number, quantity shipped, destination and estimated time of arrival (ETA) at the consignee's or customer's facility. The ASN is electronically transferred to the consignee/customer at step 1311 (sending electronic shipment record to customer). The inventory is "virtual" in the sense that the CMCS knows that it is scheduled to become inventory prior to its physical arrival, as a result of receipt of the advance shipping notice (ASN). The physical arrival of a container at step 1314 is entered into the CMCS at step 1316 (FIG. 13C) (deliver/receive shipping unit to/by

customer). By matching (comparing) the conveyance arrival data (carrier [shipping unit] and container ID) with the ASN data (using electronic shipment record) received from the carrier, the CMCS (delivery record) performs a system-to-system audit verification at step 1317, and is able to notify the customer/consignee of any discrepancies at step 1318.

Reber et al. teaches, figures 1, 4 and 6, a network navigation method using mail. The system shows an article of mail 12 include letters and packages and parcels. Associated with the article of mail are machine readable data 14 (label on shipping unit, see figure 6) Figure 3 is a block diagram of records in a database, such as databases 32 or 34, for determining the electronic address 20. Each of the records (electronic shipment records) includes an electronic address corresponding to delivery-based data for an article of mail. The registration number and the transaction identifier are associated to the label on the shipping unit and the items within the shipping unit. The customer terminal in figure 4 has the ability to electronically read the identifier on the label upon receiving the shipping unit. The system provides a more secure delivery process.

Based on the teaching of Reber et al., it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Radican system to incorporate the labeling system of Reber et al. in order to provide a more secure delivery process.

***Response to Arguments***

6. Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cuff whose telephone number is (571) 272-6778. The examiner can normally be reached on 8:00 to 5:30.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Michael Cuff 3/9/06*

Michael Cuff  
March 9, 2006